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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
MOONEYHAM, JANICE A	
ART UNIT	**PAPER NUMBER**
3629	

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/757,940	HALLIGAN ET AL.	
	Examiner	Art Unit	
	Janice A. Mooneyham	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *05 July 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *96-101,103-110 and 112-118* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *96-101, 103-110 and 112-118* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This is in response to the applicant's communication filed on July 5, 2005, wherein:

Claims 96-101, 103-110 and 112-118 are currently pending in this application.

Response to Amendment

Claim Objections

2. Claims 102 and 111 are objected to because of the following informalities: The Examiner requested the applicant to make the following changes in the May 9, 2005 Office Action. However, the changes have not been made.

Claims 102 and 111 have been canceled but have been incorrectly labeled as being withdrawn. The status identifier should indicate that the claims 102 and 113 are canceled under the Revised Amendment Practice as set forth in 37 CFR 1.121 (effective data July 30, 2003). It is requested that applicant make the appropriate correction in any subsequent responses.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 96-101, 103-110 and 112-118 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The

claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The applicant has identified an invention which requires the user to input information into a computer through the use of a questionnaire with multiple-choice questions wherein many of the questions have answers that are provided by the subjective analysis of the user. Because the answers are subjective, for a single situation, there could be different results based on the subjective analysis and determination of each user. This subjective information would result in a different value depending on the individual users. Thus, for each individual performing the invention, the result would be different and would have a different meaning. Therefore, the invention does not produce a repeatable or concrete result as required by the statute. The users of the invention must conduct a great deal of experimentation on their part in order to use the invention – to the point that the users become the inventor of their own application of the invention rather than the applicant.

Thus, the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to use the invention since the subjective interpretation does not provide a concrete result which can be used by one in the industry other than the person actually entering the information.

4. Furthermore, claims 96-101, 103-110 and 112-118 are also rejected under 35 U.S.C. 112, first paragraph since the claimed invention is not supported by

either a specific asserted utility or a well established utility. For the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention. The applicant has not defined the numerical score. There is no defined meaning as to the score. It is unclear how one skilled in the art would know how the numerical score derived by the invention would be used or what the meaning of the score is to anyone other than what it means in the mind of the person actually entering the information. It is unclear how the numerical score value would be used by a person in the industry, i.e., what would the score mean to a person in the industry, especially in view of the fact that any comparison is made by comparing the assigned values with a predetermined threshold value which is not an industry standard value or a mathematically derived standard but rather a value chosen by the user (page 15 of the remarks section to the response).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 96-101, 103-110 and 112-118 are rejected under 35 U.S.C. 101 because for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. "Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation

without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect

In the present case, many of the answers to the multiple-choice questions in the questionnaire are subjective. Thus, because the answers are subjective, for a single situation, there could be different results based on the subjective determination of the user. Therefore, the applicant's invention is not capable of providing concrete results as required by 35 U.S.C. 101 since it would be difficult for a person to repeat the analysis and determination of another based on the subjective subject matter without undue experimentation.

Furthermore, the claimed invention is not supported by either a credible asserted utility or a well established utility. It is unclear how the specific utility of the claimed invention as described in the disclosure of this application would be useful or tangible to one in the industry. It is unclear how the numerical score value would be used by a person in the industry, i.e., what does the score mean to a person in the industry, especially in view of the fact that any comparison is made by comparing the assigned values with a predetermined threshold value which is not an industry standard value or a mathematically derived standard but rather a value chosen by the user (page 15 of the remarks section to the response). For example, an academic test score of 95 is considered an A unless specifically defined otherwise. What does the numerical score value that is derived by this invention mean and to whom does it have a meaning. Is there a threshold value that has a real world meaning?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 96, 103-105, 112-114 and 118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spencer (US 6,356,909) (hereinafter referred to as Spencer) in view of Barney et al (6,556,992) (hereinafter referred to as Barney).

Regarding Claims 96, 105 and 114:

Spencer discloses computer method, system and program, comprising:

providing a questionnaire of multiple-choice questions (Figures 14, col. 12, line 65 thru col. 13, line 18 - *multiple choice questions*) ;

providing a numerical score value to each of the responses on the questionnaire (col. 12, line 65 thru col. 13, line 18 *multiple choice questions may have a sliding value depending on the answer selected. Each question/selection is given a weight that is used to develop a scorecard*);

accepting responses to the questionnaire through the input device (col. 13, lines 11-18 *individual question responses*, Figure 3A – (4) *Response database*);

converting the responses received to a numerical score value (col. 12, line 65 thru col. 13, line 18 *scorecard*).

Spencer does not disclose that the subject matter of the invention is trade secrets or that the questions relate to the six factors for a trade secret of the First Restatement of Torts, or calculating a geometric mean, the sixth root of the product, of the numerical score values to create a single metric, or repeating the program for each of the remaining items to be evaluated or ranking the items in ascending or descending order of the calculated metric.

However, Barney discloses repeating the program for each of the remaining items to be evaluated and ranking the items, wherein the items are patents and other intangible intellectual property assets (*trade secrets*) (col. 5, lines 56-62, col. 6, lines 3-9 *ratings or rankings are generated using a database of information by identifying and comparing various characteristics of each patent to a statistically determined distribution of the same characteristic within a given patent population*, col. 7, lines 51-60 – *ranking in ascending or descending order is inherent in the definition of ranking as admitted by applicant on page 18 or the Remarks*).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the ranking of intellectual property assets as taught by Barney into the disclosure of Spencer so as to allow an entity to identify and study relevant characteristics of intellectual property to determine and measure those metrics that are predictive of a possible future event, such as an intangible intellectual property asset being litigated.

Although Barney discloses a rating for patents and other intangible intellectual property assets, neither Spencer or Barney explicitly disclose rating

trade secrets or the questions relating to the six factors for a trade secret of the First Restatement of Torts or calculating a geometric mean, the sixth root of the product, of the numerical score value.

However, a geometric mean is old and well known. Geometric mean as defined by the Merriam Webster on line dictionary as:

> Main Entry: **geometric mean**
> Function: *noun*
> : the nth root of the product of *n* numbers; *specifically* : a number that is the second term of three consecutive terms of a geometric progression <the *geometric mean* of 9 and 4 is 6>

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Spencer to include a geometric mean that is the sixth root of the product since the applicant has identified six factors for a trade secret, thus the 6^{th} root of the product of 6 numbers to come up with a numerical score value which can be used for comparison purposes when making an analysis of the trade secret.

The fact that the subject matter is about trade secrets or that the questions relate to the First Restatement of Torts is determined to be non-functional descriptive data. The language is not functionally interrelated with the useful acts, structure or properties of the claimed invention. The weighted scoring and ranking would be performed the same regardless of the data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack,* 703 F. 2d 1381, 1385, 217 USPQ 401,

404 (Fed. Cir. 1983), *In re Lowry,* 32 F. 3d. 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide weighted scoring and ranking of trade secrets because such data does not functionally relate to the steps of the method or the structure of the system and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Regarding Claims 103 and 112:

Barney discloses assigning the value further comprises assigning numeric values on a scale of one to five or a scale of zero to ten (col. 9, lines 28-37,col. 24, lines 36-49 *ratings are provided on a scale from 1-10*).

Regarding Claims 104, 113 and 118:

Barney discloses wherein generating one or more metrics further comprises comparing the assigned values with predetermined threshold values (col. 6, lines 3-23 *comparing various characteristics of each patent to a statistically determined distribution (threshold) of the same characteristic*).

Claims 97-101, 106-110, 115-117 rejected under 35 U.S.C. 103(a) as being unpatentable over Spencer and Barney as applied to claims 96, 105 and 114 above, and further in view of Haber et al (US 5,136,646) (hereinafter referred to as Haber)

Regarding Claims 97,106 and 115:

Neither Spencer or Barney disclose an application fingerprint of the data.

However, Haber discloses creating an application fingerprint of the data (col. 3, lines 50-55).

It would have been obvious to one of ordinary skill in the art to combine the fingerprint as taught by Haber with the scoring and ranking disclosed in Spencer and Barney so that once the scored and ranked information is stored, there is a way to verify the date so that, should the time become a matter for later proof, the established procedure serve as effective evidence in substantiating the fact.

Regarding Claims 98 and 107:

Haber discloses creating the application fingerprint comprises processing the content using a deterministic one-way algorithm (col. 3, lines 29-49).

Regarding Claims 99, 108 and 116:

Haber discloses transferring the fingerprint from a creator to a trusted third party (col. 2, lines 32-40 (outside agency), col. 3, lines 6-9 (*outside time-stamping agency (TSA)*).

Regarding Claims 100, 109 and 117:

Haber discloses creating a certificate fingerprint from the application fingerprint by the trusted third party (col. 4, lines 22-40).

Regarding Claims 101 and 110:

Haber discloses transmitting the certificate fingerprint from the trusted third party to the creator of the application fingerprint as a certificate (abstract – *the certified receipt bearing the time data and the catenate certificate number is then returned to the author as evidence of the document's existence*, col. 4, lines 22-40).

Response to Arguments

Applicant's arguments filed July 5, 2005 have been fully considered but they are not persuasive.

I. Claims 96-101, 103-110 and 112-118 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement and the claimed invention is not supported by a specific asserted utility or a well established utility.

The applicant argues that no computerized method would be enabling since, as the applicant states the Examiner position, all computer programs require user input. The applicant states that as the output depends on input, the output cannot be considered concrete by the Examiner. The applicant fails to understand the Examiner's position. The Examiner is not suggesting that just

because the user inputs information into the computer that this is the reason for the rejection for lack of enablement. It is the subjective nature of the applicant's input into the computer that raises the question of enablement. The applicant states on page 3 of the response that the "essence of the independent claims is a method or apparatus that aggregates user judgment". The applicant then states that the invention is for "condensing the user's judgment into one variable". It is this subjective input that creates the lack of enablement. Because the applicant's invention involves the subjective analysis of the user, the invention would require undue experimentation by another user.

The applicant argues that the Examiner's argument with respect to a useful, concrete, and tangible result also fails. The applicant states that if a well established utility did exist for the instant invention, the invention would not be novel. This argument is not relevant. The applicant states that the specific utility of the invention is the ability to rank trade secrets according to a metric that aggregates the judgment of the evaluator on six independent variables of importance in the determination of a trade secret.

MPEP section 2164.07 states that 35 U.S.C. 112, first paragraph requires an indication of how the use of the invention can be carried out, how the invention can be used. The result of the invention has no utility because a person skilled in the art would not be able to use the invention. The applicant has not defined the numerical score. The applicant has not defined how one skilled in the art would know what the numerical score derived by the invention

would mean. How would a person skilled in the art apply the score? How would one in the industry know what the score meant?

Because the answers are subjective, for a single situation, there could be different results based on the subjective analysis and determination of each user. This subjective information would result in a different value depending on the individual users. Thus, for each individual performing the invention, the result would be different and would have a different meaning. Therefore, the invention does not produce a repeatable or concrete result as required by the statute. The user of the invention must conduct a great deal of experimentation on their part in order to use the invention – to the point that the users become the inventor of their own application of the invention rather than the applicant. Furthermore, the fact that each user could come up with a different value with a different meaning, then how can one in the industry utilize the number?

Thus, the claims contain subject matter was not described in the specification in such a way as to enable one skilled in the art to use the invention since the subjective interpretation does not provide a concrete result which can be used by one in the industry other than the person actually entering the information.

As for the applicant's arguments regarding the predetermined threshold values and the ranking of the trade secrets, since the applicant has failed to define the predetermined threshold values, then once again, each user is left to determine their own threshold values. Because each user is making subjective analysis, then any number that results from this analysis would not be concrete

since it is hard to reproduce another's subjective determination. Therefore, since there are no defined values that are repeatable, then the ranking of the trade secrets would have different meanings and be ranked differently by each of the users. Therefore, the invention does not produce a repeatable or concrete result as required by the statute. Furthermore, the invention has no utility because a person skilled in the art would not be able to use the invention.

II. Claims 96-101, 103-110 and 112-118 are rejected under 35 U.S.C. 112, second paragraph. This rejection has been withdrawn.

III. Claims 96-101, 103-110 and 112-118 are rejected under 35 U.S.C. 101 because for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

The applicant asserts that the specific asserted utility is the ability to rank trade secrets according to a metric that aggregates the judgment of the evaluator on six independent variables of importance in the determination of a trade secret. The fact that the invention aggregates the judgment of the evaluator means the invention involves subjective analysis and thus is not concrete.

The applicant states that the Examiner has acknowledged that the derived score would have meaning to the person actually entering the information. The applicant then states that invention produces a useful, concrete and tangible result for that person. However, the claims contain subject matter was not described in the specification in such a way as to enable one skilled in the art to use the invention since the subjective interpretation does not provide a concrete result which can be used by one in the industry other than the person actually

entering the information. The user of the invention must conduct a great deal of experimentation on their part in order to use the invention – to the point that the users become the inventor of their own application of the invention rather than the applicant.

IV. Claims 96, 103-105, 112-114 and 118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spencer in view of Barney.

The applicant argues that it is not obvious to one skilled in the art at the time of the invention to modify Spencer to include a geometric mean. The applicant then states that applicants tested a large number of mathematical functions to determine that the geometric mean provided a numerical score value that predicted the considered profession evaluation of people familiar with trade secret litigation. However, in the specification, the applicant states:

> For example, once values have been assigned under the relevant criteria, the assigned values may be averaged to provide the relevant metric. Alternatively, the six assigned values may be multiplied and the sixth root taken of the product. The metric obtained using such process may be compared by the user or by the accounting system (e.g., within a comparator processor) with a threshold value. Where the metric exceeds the predetermined threshold level, a determination may be made that a protectable trade secret exists.

Thus, it appears that several methods of obtaining the relevant metric may work.

As for applicant's arguments as to the non-functional descriptive data, the Examiner refers the applicant to the discussion with the rejection. The invention is providing a questionnaire with multiple choice questions, each response have

a numerical value, wherein a single metric is created and the metrics are ranked. The scoring and ranking would be performed the same regardless of the data. Thus, the data is non-functional descriptive data.

V. Claims 97-101, 106-110, 115-117 rejected under 35 U.S.C. 103(a) as being unpatentable over Spencer and Barney as applied to claims 96, 105 and 114 above, and further in view of Haber.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JM

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